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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,995	08/22/2003	Graeme Horwood	9808-155/CPA	8679
27572	7590	06/01/2005	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,995

Applicant(s)

HORWOOD ET AL.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/22/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence(s) of the specification or in an application data sheet by identifying the prior application by application number (37 CFR 1.78(a)(2) and (a)(5)). If the prior application is a non-provisional application, the specific reference must also include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 and 5-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,729,970. Although the conflicting claims are not identical, they are not patentably distinct from each other because the two of the subsets claimed in this application are contained in the three subsets claimed in patent 6,729,970.

4. Claims 4 and 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,729,970 in view of 11-192328.

Claims 1-7 of U.S. Patent No. 6,729,970 lacks one subset of shaft including a 3,4 and 5 iron, and a second subset including a 6, 7,8,9 and wedge. 11-192328 discloses only two subsets of shafts (Page 4). 11-192328 does not disclose the two subsets being divided between the 5 iron and 6 iron but clearly an artisan skilled in the art of utilizing different materials for shafts in a subset would have selected a suitable division in a set in which between a 5 iron and a 6 iron is included. In view of the publication of 11-192328 it would have been obvious to modify the set of clubs of claims 1-7 of U.S. Patent No. 6,729,970 to have one subset of shaft including a 3,4 and 5 iron, and a second subset including a 6, 7,8,9 and wedge in order to simplify the manufacturing of a set by only have two different types of material and in order to have a more stiffer set of clubs for the 6-9 irons.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by 11-192328.

11-192328 discloses a set of golf clubs with a first shaft subset including a 3-9 iron made of CFRP (Sets 1, 2 on second table on page 5) with shafts lengths within a range (Top table on page 5), and another shaft subset made of material of steel including a PW, AW, and SW (Sets 1, 2 on second table on page 5, Bottom table on page 4, Verbal Translation) with shafts lengths with a range in the form of all shafts lengths are 35 inches which fits within a range of 35.7 to 34 inches (Top table on page 5).

7. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Murtland.

With respect to claims 7-8, Murtland discloses a first material shaft subset of steel (Col. 4, Lns. 47-59) including a 3 iron, 4 iron and 5 iron (Table in Col. 8), and a second material shaft subset of composite (Col. 4, Lns. 47-59) including a 6 iron, 7 iron, 8 iron, 9 iron and wedge (Table in Col. 8).

With respect to claims 7 and 9, Murtland discloses a first material shaft subset of composite (Col. 4, Lns. 60-67) including a 3 iron, 4 iron and 5 iron (Table in Col. 8), and a second material shaft subset of composite/metal (Col. 4, Lns. 47-67) including a 6 iron, 7 iron, 8 iron, 9 iron and wedge (Table in Col. 8).

With respect to claims 7 and 10, Murtland discloses a first material shaft subset of composite/metal (Col. 4, Lns. 47-67) including a 3 iron, 4 iron and 5 iron (Table in Col. 8), and a second material shaft subset of metal (Col. 4, Lns. 47-59) including a 6 iron, 7 iron, 8 iron, 9 iron and wedge (Table in Col. 8).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murtland (6,343,999) in view of Fenton and Cook.

Murtland discloses a shaft subset consisting of a composite/metal combination shafts (Col. 4, Lns. 47-67) for irons and wedges having a predetermined range in lengths (Col. 8, Lns. 40-60).

Murtland lacks a second shaft subset consisting of composite shafts having lengths in a predetermined range different than a first shaft subset.

Fenton discloses a wood shaft consisting of a composite material (Figs. 2-5). Cook discloses shaft subset of wood have a shaft length in a predetermined ranges different than the iron shaft lengths disclosed by Murtland or Cook itself (Col. 11, Lns. 1-30). In view of the patents of Fenton and Cook it would have been obvious to modify the set of clubs of Murtland to include a set of woods having lengths in a predetermined range different than a first shaft subset in order to have a more clubs to select from with different hitting distances for the same swing when playing a round of golf. In view of the patents of Fenton and Cook it would have been obvious to modify the set of clubs of Murtland to have the wood shafts being composite material in order to have wood clubs with light weight shafts yet with strength and flexibility.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over 11-192328.

11-192328 discloses having a different sets with different number of irons being made of each material (Bottom table page 5). An artisan skilled in the art of utilizing two different materials to form an iron set of shafts would have selected a suitable

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combination of irons using each of the different materials in which a subset formed of a 6-9 iron and wedge all being formed of metal is included.

11-192328 lacks another subset including 6-9 irons. It would have been obvious to modify the set of irons of 11-192328 to have another subset including 6-9 irons in order to utilize the advantages of the material used for the wedges for the high number irons in addition.

11. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over 11-192328 in view of Doolen.

11-192328 lacks heads having different lofts.

Doolen discloses a set of irons with each head having different lofts (Table). In view of the patent of Doolen it would have been obvious to have a shaft subset having lofts within a first range and another shaft subset having lofts within a second range with the ranges being different in order to have clubs which hit different distances for the same swing when playing a round of golf.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone

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number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 25 May 2005



STEPHEN BLAU
PRIMARY EXAMINER